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6 LUMILEDS LIGHTING U.S., LLC

7 UNITED STATES DISTRICT COURT  
8 NORTHERN DISTRICT OF CALIFORNIA  
9 SAN JOSE DIVISION

10 EPISTAR CORPORATION,  
11 Plaintiff and Counterclaim Defendant,  
12 v.  
13 LUMILEDS LIGHTING U.S., LLC,  
14 Defendant and Counterclaim Plaintiff.

Case No. C-03-1130 HRL

**LUMILEDS LIGHTING U.S., LLC'S  
NOTICE OF RELATED CASES**

16 Pursuant to Civil L. R. 3-12, Lumileds Lighting U.S., LLC ("Lumileds") hereby serves  
17 notice that the present action is related to both *Lumileds Lighting U.S., LLC v. Citizen*  
18 *Electronics Co., Ltd, Cecol, Inc. and Epistar Corp.*, No. C 02-5077 CW (EAI) (N.D. Cal. filed  
19 October 18, 2002) (Wilken, J.) ("Epistar Related Action") and *United Epitaxy Co., Ltd. v.*  
20 *Hewlett-Packard Co., Agilent Technologies, Inc. and Lumileds Lighting U.S., LLC*, No. C 00-  
21 2518 CW (PVT) (N.D. Cal. filed September 7, 1999) (Wilken, J.) ("UEC Related Action").

22 **Statement of the Relationship of the Actions**

23 **1. The Epistar Related Action**

24 Both the present action and the Epistar Related Action are based on the same dispute over  
25 Epistar's infringement of Lumileds' U.S. Patent No. 5,008,718 ("the '718 patent"). Thus, the  
26 present action shares the same parties, the same property, and the same transactions, events, and  
27 questions of law with the Epistar Related Action. In particular, the present action includes  
28 Epistar's claims seeking a declaration of invalidity and non-infringement of the '718 patent and

1 Lumileds' counterclaim for infringement against Epistar. (O'Neil Decl., Ex. 1, Epistar's  
2 Complaint; Ex. 2, Lumileds' Answer and Counterclaim). The Epistar Related Action, which is  
3 presently before Judge Wilken in the Northern District of California, includes Lumileds' claim  
4 for infringement of the '718 patent against not only Epistar, but also its customers, Citizen  
5 Electronics Co., Ltd. and Cecol, Inc. (O'Neil Decl., Ex. 3, Lumileds' First Amended  
6 Complaint). It is not yet clear whether Epistar intends to file a counterclaim for declaratory  
7 judgment in the Epistar Related Action because Epistar has defaulted on its obligation to answer  
8 the First Amended Complaint.

## 9 **2. The UEC Related Action**

10 Both the present action and the UEC Related Action involve Lumileds' assertion of  
11 infringement of the '718 patent. Thus, the present case shares a common party, the same  
12 property, and many of the transactions, events, and questions of law with the UEC Related  
13 Action.

14 Judge Wilken has already issued a Related Case Order indicating that the Epistar Related  
15 Action is related to the UEC Related Action. (O'Neil Decl., Ex. 4). For all the same reasons  
16 stated in Lumileds' Notice of Related Action filed in the Epistar Related Action (O'Neil Decl.,  
17 Ex. 5), the present case should also be declared related to the UEC Related Action.

### 18 **Conservation of Judicial Resources**

19 Assignment of the present case to Judge Wilken, who presided over the UEC Related  
20 Action and who currently presides over the Epistar Related Action, will conserve judicial  
21 resources and promote an efficient resolution of the dispute. Since the present action and the  
22 Epistar Related Action are based upon the same dispute, a single Judge should preside over both  
23 matters. Moreover, as was explained in Lumileds' previous Notice of Related Action, Judge  
24 Wilken invested significant time in resolving many of the legal and factual questions in the UEC  
25 Related Action that are likely to be at issue in the present case as well. (*Id.*) Thus, Judge Wilken  
26 is already familiar with many of the complex issues regarding infringement, validity and  
27 enforceability of the '718 patent.

1 This case has been transferred to the Northern District, at least in part, because it is more  
 2 efficient to try these closely-related cases before a single judge. As Judge Audrey Collins  
 3 explains in her transfer order:

4 Citing the interest of judicial economy, Defendant contends that  
 5 this case should be transferred because there is a pending case between  
 6 LumiLeds and Epistar regarding the '718 patent before Judge Wilken of  
 7 the Northern District. Defendant also points out that Judge Wilken heard  
 8 a case regarding the '718 patent before. According to the Ninth Circuit,  
 9 "[t]he feasibility of consolidation is a significant factor in a transfer  
 10 decision[.]" A.J. Industries, Inc. v. U.S. District Court, 503 F.2d 384, 389  
 11 (9<sup>th</sup> Cir. 1974) (citing van Dusen v. Barrack, 376 U.S. 612, 645 (1964)).  
 Further, "the pendency of an action in another district is important because  
 of the positive effects it might have in possible consolidation of discovery  
 and convenience to witnesses and parties." Id. (citing Schneider v. Sears,  
 265 F. Supp. 257, 267 (S.D.N.Y. 1967); Rodgers v. Northwest Airlines,  
Inc., 202 F. Supp. 309, 312 (D.C.N.Y. 1962)). Because the other case  
 involves the same parties, witnesses and evidence, Defendant urges the  
 Court to transfer the case.

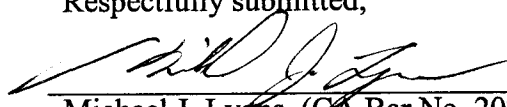
12 The Court agrees with Defendant. Because Judge Wilken has a  
 13 case pending regarding the '718 patent, and because she has dealt with a  
 14 case regarding the same patent before, it would be a more efficient use of  
 15 judicial resources to hear the case in the Northern District. For this  
 reason, this factor weighs in favor of transfer. The Court finds that on  
 balance the factors weigh in favor of transferring the case to the Northern  
 District of California.

16 (O'Neil Decl., Ex. 6, Order Granting Defendant's Motion to Transfer Venue, at 8-9).

17 Accordingly, the present case should be declared related to both the Epistar Related Action and  
 18 the UEC Related Action.

19 Respectfully submitted,

20 Dated: March 20, 2003

21   
 22 Michael J. Lyons (CA Bar No. 202284)  
 23 Andrew J. Wu (CA Bar No. 214442)  
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25 Attorneys for Defendant and Counterclaim  
 26 Plaintiff, Lumileds Lighting U.S., LLC.

**CERTIFICATE OF SERVICE**

I am employed in the City of Palo Alto, County of Santa Clara, State of California, I am over the age of 18 years and not a party to the within action. My business address is 3300 Hillview Avenue., Palo Alto, California 94304. On March 20, 2003, I caused copies of the attached document(s) described as follows:

**LUMILEDS LIGHTING U.S., LLC'S NOTICE OF RELATED CASES  
DECLARATION OF JOHN G. O'NEIL IN SUPPORT OF LUMILEDS  
LIGHTING U.S., LLC'S NOTICE OF RELATED CASES**

to be served on

Michael S. Adler, Esq.  
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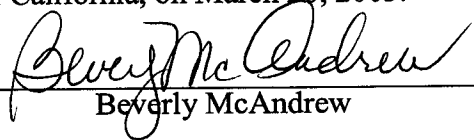
       (BY PERSONAL SERVICE) The person whose name is noted below caused to be delivered by hand each such envelope to the addressee(s) noted above.

       (BY FIRST CLASS MAIL) I caused each such envelope to the addressee(s) noted above, with postage thereon fully prepaid, to be placed in the United States mail in Palo Alto, California. I am readily familiar with the practice of Pennie & Edmonds LLP for collection and processing of correspondence for mailing, said practice being that in the ordinary course of business mail is deposited in the United States Postal Service the same date as it is placed for collection.

XX (BY OVERNIGHT DELIVERY) I caused each such envelope to the addressee(s) noted above, with charges fully prepaid, to be sent by overnight delivery from Palo Alto, California. I am readily familiar with the practice of Pennie & Edmonds LLP for collection and processing of correspondence for overnight delivery, said practice being that in the ordinary course of business, mail is placed with the overnight delivery service on the same day as it is placed for collection.

XX (BY FACSIMILE) The person whose name is noted below caused to be transmitted by facsimile each such document to the addressee(s) noted above.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California, on March 20, 2003.

  
Beverly McAndrew

**CERTIFICATE OF SERVICE**

I am employed in the City of Palo Alto, County of Santa Clara, State of California, I am over the age of 18 years and not a party to the within action. My business address is 3300 Hillview Avenue., Palo Alto, California 94304. On March 20, 2003, I caused copies of the attached document(s) described as follows:

**LUMILEDS LIGHTING U.S., LLC'S NOTICE OF RELATED CASES  
DECLARATION OF JOHN G. O'NEIL IN SUPPORT OF LUMILEDS  
LIGHTING U.S., LLC'S NOTICE OF RELATED CASES**

to be served on

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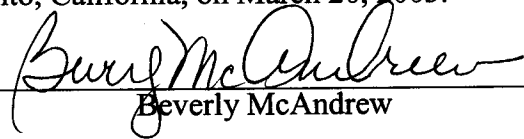
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Beverly McAndrew